

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Britto, et al.

Confirmation No. 2026

Appl. No. : 09/312,028

Filed : May 14, 1999

For : COMPUTER-ASSISTED FUNDS
TRANSFER SYSTEM

Examiner : Daniel S. Felten

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Arlington, VA 222313-1450

Dear Sir:

Applicants respectfully request review of the rejection set forth in the Final Office Action dated November 14, 2007 (hereinafter "the Final Office Action"). The review is requested for the reasons stated on the following pages. This request is being filed with a Notice of Appeal. No amendments are being filed with this request. Please charge any additional fees that may be due to deposit account 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 14, 2008By: /RJS38297/

Ronald J. Schoenbaum
Registration No. 38,297
Attorney of Record
2040 Main Street
Irvine, CA 92614
949-721-2950

Appl. No. : 09/312,028
Filed : May 14, 1999

I. Claims 56-61, 63-68, 72 and 73 are not rendered obvious by Rose in combination with ordinary business practice.

Claims 56-61, 63-68, 72 and 73 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. 5,757,917 (“Rose”) in view of alleged “ordinary business practice.” Claim 56 is the sole independent claim. Applicants respectfully submit that the rejection is improper because the Final Office Action does not establish a prima facie case of obviousness.

Claim 56

Claim 56 is reproduced below, with highlighting to show examples of claim limitations not taught or suggested by the cited art.

56. A computer-implemented method of reducing e-commerce fraud, the method comprising:

receiving a payment request at a computer system that implements a user-to-user funds transfer service, said payment request generated by a buyer via a web form of the computer system, and specifying a seller and a payment amount to transfer to the seller, said payment request being associated with a sales transaction between the buyer and the seller;

in response to the payment request, performing an automated fraud check of at least said seller, said automated fraud check comprising an automated assessment of data associated with the seller, including data obtained from a third party not directly associated with the transaction;

when the automated fraud check produces an adverse indication, declining the payment request; and

when the automated fraud check does not produce an adverse indication, processing the payment request by causing the payment amount to be transferred from the buyer to the seller.

“Receiving a payment request...to transfer to the seller”

The rejection of claim 56 is improper because, among other reasons, the cited art does not teach or suggest a method that comprises receiving a payment request generated by a buyer as recited in the first highlighted portion of the claim. In contrast, the payment requests in Rose are generated by the seller. See Rose at col. 8, lines 12-26.

In connection with this issue, the Final Office Action points to the following portions of Rose: col. 1, line 66 to col. 2, lines 16; Fig. 1; col. 2, lines 57+, and col. 8, lines 1-26. These portions of Rose refer to two types of messages generated by the buyer. Neither, however,

Appl. No. : **09/312,028**
Filed : **May 14, 1999**

satisfies the limitations at issue. The first such message 128 is sent by the buyer to notify the seller of the buyer's "cardnumber." This message 128 is not a "payment request" that is received "at a computer system that implements a user-to-user funds transfer service" as claimed. Rather, it is a message that is sent directly from the buyer to the seller to provide the seller with account information needed to send a payment request message to the payment system 10. See col. 8, lines 1-26.

The second type of message sent by the buyer in Rose is a payment-response message 150. This message 150 contains the buyer's indication ("yes," "no" or "fraud") of whether to authorize the seller-requested transfer of funds. See col. 9, lines 23-50. This message 150 is not generated by the buyer "via a web form of the computer system" that implements the user-to-user funds transfer service as claimed. Rather, the buyer generates this message by responding to an email message. See col. 8, lines 59-62 and col. 9, lines 32-50.

Thus, the cited portions of Rose do not teach or suggest the limitations at issue. Because these limitations are not taught or suggested, and because the Final Office Action makes no attempt to explain why the associated differences between the claim and the cited art would have been obvious, the Final Office Action does not establish a prima facie case of obviousness.

"In response to the payment request, performing an automated fraud check...transaction."

The rejection of claim 56 is also improper for the independent reason that the cited art does not teach or suggest the second highlighted portion of the claim. In connection with this issue, the Final Office Action points to Rose's determination of "whether the payment-request message is from a qualified seller." See Rose at col. 8, lines 27-38. Nothing in Rose, however, suggests that this determination involves an assessment of "data obtained from a third party not directly associated with the transaction." Rather, this task apparently involves checking a database 91 to confirm that the payment-request message corresponds to a valid seller account. Further, Rose's determination is performed in response to a seller-generated payment request message, and not a buyer-generated payment request as claimed.

The Final Office Action also points to col. 8, lines 59-67; col. 6, lines 5-21; Fig. 7; and col. 10, lines 15-29 of Rose. Neither these nor any other portion of Rose, however, suggests responding to a buyer-generated payment request by "performing an automated fraud check of at least said seller," where the automatic fraud check includes an assessment of "data obtained from a third party not directly associated with the transaction."

Appl. No. : **09/312,028**
Filed : **May 14, 1999**

Thus, the referenced portions of Rose do not teach or suggest the second portion of claim 56 highlighted above. Because these limitations are not taught or suggested, and because the Final Office Action does not explain why the associated differences between the claim and the cited art would have been obvious, the Final Office Action does not establish a prima facie case of obviousness.

Examiner's reliance on "ordinary business practice"

In connection with a subsequent portion of claim 56, the Final Office Action alleges that it is "ordinary business practice" to authenticate or "verify" a user before a transaction takes place. Final Office Action at paragraph bridging pages 3 and 4. Even if, *arguendo*, this assertion is accurate, it does not follow that it was known or obvious at the time of the invention to perform an automated fraud check of the seller in the context of the other steps recited in claim 56. To the extent the Examiner may be relying on Official Notice in connection with this feature, Applicants respectfully traverse and challenge such use of Official Notice.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of claim 56 is improper.

Dependent Claims 57-61, 63-68, 72 and 73

Claims 57-61, 63-68, 72 and 73 depend from claim 56, and are therefore patentable over the applied art for the reasons explained above. In addition, at least some of these dependent claims recite additional distinctions over the applied art, and are therefore patentable on their own merit.

As one example, claim 57 adds that "the automated fraud check additionally includes an automated fraud check of the buyer." Rose does not teach or suggest this feature, and the Final Office Action does not contend otherwise.

As another example, claim 58 adds the following: "wherein performing the automated fraud check comprises taking said payment amount into consideration in assessing a risk associated with the transaction." The Final Office Action cites col. 6, lines 15-27 of Rose in connection with this feature. The cited portion of Rose, however, does not involve an automated fraud check as claimed. Rather, it involves a manual process in which a clerk places a call to a bank to determine whether a particular dollar amount can be charged to the buyer's credit card.

As yet another example, claim 59 adds that "the third party is a credit bureau." Nothing in Rose, however, suggests assessing data obtained from a credit bureau as part of "an automated

Appl. No. : **09/312,028**
Filed : **May 14, 1999**

fraud check of at least said seller” as claimed. The cited portions of Rose, Fig. 1 and col. 6, lines 16+, do not teach or suggest this feature.

II. Claims 70 and 71 are not rendered obvious by Rose, in view of ordinary business practice, in further view of Walker.

Claims 70 and 71 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Rose in view of alleged “ordinary business practice,” in further view of U.S. Pat. 5,794,207 (“Walker”). The rejections of claims 70 and 71 are improper because these claims depend directly or indirectly from claim 56. In addition, the rejections of these claims are improper because the cited references do not collectively teach or suggest performing an automated fraud check of a seller in an Internet auction transaction in the context of the method of claim 56.

III. The Final Office Action improperly withdraws Claims 81-87 from consideration

Claims 81-87 correspond to claims 56-59, 65, 66 and 71, but are drafted as “computer-readable medium” claims. The Final Office Action withdraws these computer-readable medium claims from consideration because they recite “a computer-readable medium having stored thereon a computer program”, and are therefore allegedly independent or distinct from the counterpart computer-implemented-method claims. Final Office Action at page 2. Applicants submit that the withdrawal of these claims is improper.

Under 35 U.S.C. § 121, restriction is proper where the inventions are “independent and distinct.” According to MPEP 802.01, the term “independent” means that “there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect.” The term “distinct” additionally requires that one of the inventions be patentable (novel and non-obvious) over the other, although not necessarily patentable over the prior art.

The recitation of a “computer-readable medium having stored thereon a computer program” in claims 81-87 does not satisfy either of these tests. In this regard, the recited computer-readable medium does not render the claims “unconnected in design, operation, and effect,” and does not render one group of claims patentable over the other. Indeed, claims 81-87 are directed to the same invention as the counterpart method claims, but are merely written in a different form. Thus, Applicants request reinstatement of claims 81-87, and request that these claims be allowed for the same reasons as the counterpart method claims.